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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,482	11/02/2001	Keith Wood	10743/3	3594

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EXAMINER

GITOMER, RALPH J

ART UNIT	PAPER NUMBER
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1655

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

The RCE Request and amendment received 10/3/05 have been entered and claims 1-33, 68-74, 79-83 are considered here.

Claims 1-33, 68-74, 79-83 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The core compound of formula XII is old. A preliminary search revealed too many citations to present here that read on the compounds as claimed. On page 19 of the present specification, formula XII is shown where R11, R14 or R15 is a cleavable protecting group and the structure is a protecting group on the carbonyl of a coelenterazine. As claimed, R11, R14, or R15 can be anything except not all can be acetyl groups. Such compounds would not function as described and are old.

Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive.

Applicants argue that the specification teaches how to make and use the compounds and each of the R groups are defined.

It is the examiner's position that the above rejection is made under 35 USC 112, first paragraph, where one of skill in this art could not make and use each and every of the innumerable compounds encompassed by the claims as claimed.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-33, 68-74, 79-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

In claim 1 "a protecting group that is removable by an enzyme" is indefinite as it could read on H or a methyl group or most anything. What is protected such as the ring is not set forth. This is so indefinite as to be unsearchable. Claim 3 fails to further limit claim 1 because the stated R groups are attached to O. Claim 33 describes a compound in functional terms where one would not know the metes and bounds of the claim.

Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive.

Applicants argue that the specification defines "a protecting group that is removable by an enzyme" and each of the R groups are defined. In claim 33 the compound is a modified coelenterazine compound.

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It is the examiner's position that "enzyme removable group" reads on H as well as most any compound, known or unknown. The limitations of the specification are not read into the claims. One would not know if a modified coelenterazine compound is encompassed by claim 33 because the claims does not state how the compound is modified.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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